

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/544,154 Confirmation No. 6432
Applicant : Francis X. Smith et al.
Filed : August 1, 2005 Art Unit: 1612
Title : L-HISTIDINE IN OPHTHALMIC SOLUTIONS
Examiner : Basquill, Sean M.
Docket No. : 3009099 US01
Customer No. : 44,331

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellant hereby requests an appeal conference for review of claims 1-20 for the above referenced application.

A timely Notice of Appeal, in compliance with 37 CFR 41.31, is filed with this Pre-Appeal Brief Request for Review.

Status Of The Claims:

Claims 1-20 are pending in the application.

Claims 1-20 are rejected.

Claims 1-20 are hereby appealed.

Status Of Amendments:

A Response After Final was filed on April 5, 2010, subsequent to the Final Rejection. An Advisory Action dated April 19, 2010 was then received indicating that the claims are not in condition for allowance.

Remarks

Response to Advisory Action:

The Advisory Action dated April 19, 2010 indicates that the remarks file on April 5, 2010 have been considered but that they do not put the application in condition for allowance. The Examiner indicates that Chowhan et al. (U.S. Patent No. 5,741,817) cannot logically teach away from the use of EDTA because the reference discloses that EDTA is used within the ophthalmic art. However, applicants arguments set forth in the request for reconsideration filed April 5, 2010 have been misconstrued.

Application contests that combining a reference that utilizes EDTA with Chowhan frustrates the purpose of the Chowhan reference. It is well established that if a proposed modification would render the reference unsatisfactory for its intended purpose, then the combination is not proper. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). When viewing Chowhan et al. as a whole, the reference explicitly indicates that the ophthalmic solution should not contain EDTA. While the Examiner indicates that the use of EDTA is well-known in the art, Chowhan et al. explicitly indicates that the ophthalmic solutions disclosed should not contain EDTA. In determining the differences between reference and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Furthermore, a prior art reference must be considered in its entirety, even including portions of the reference that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). It has been established that where the teachings of two or more prior art references conflict, the examiner consider the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588 (Fed. Cir. 1991). In the instant matter, when viewing Chowhan as a whole, one of ordinary skill in the art would be influenced to create a solution without EDTA present. Therefore, combining Chowhan with a reference that teaches a solution containing EDTA in order to substantiate an obviousness rejection is improper as the proposed combination frustrates the purpose of the Chowhan reference.

Rejection under 35 U.S.C. § 103(a) over Mowrey-McKee in view of Chowhan:

In section 2 of the Office Action dated December 3, 2009, the Examiner has rejected claims 1-3 and 5-20 under 35 § U.S.C. 103(a) as being unpatentable over Mowrey-McKee et al. (U.S. Patent No. 5,817,277) in view of Chowhan et al. This rejection is respectfully urged as in error for at least the following reasons.

As discussed above, combination of the teachings of Mowrey-McKee et al. with the teachings of Chowhan et al. is improper. The proposed combination frustrates the purpose of Chowhan et al. The stated purpose of Chowhan et al. is to produce an ophthalmic composition that does not contain EDTA. *See*, Col. 1, Lns. 29-33; Col. 1, Lns. 50-58; Col. 3, Lns. 22-23; and Cl. 1. If a proposed modification would render the reference unsatisfactory for its intended purpose, then the combination is not proper. *In re Gordon*. By contrast, Mowrey-McKee et al. discloses utilizing EDTA as a preferred component of the ophthalmic solution. Here Chowhan et al. and Mowrey-McKee et al. are in stark contrast to one another, and when viewing Chowhan et al. as a whole, the proposed modification frustrates the purpose of the reference thereby rendering the combination improper.

Further, Mowrey-McKee et al. does not describe L-histidine in an ophthalmic solution. The Examiner relies on Chowhan et al. to teach this limitation, indicating that it would be obvious to include low molecular weight amino acids to improve the efficacy of antimicrobial preservatives in ophthalmic solutions. However, Chowhan et al. lacks sufficient specificity to teach one skilled in the art the use of L-histidine. The instant claims are specifically limited to the inclusion of L-histidine. By contrast, Chowhan et al. discloses a sizable list of suitable amino acids, with the only guidance given being a preference for low molecular weight amino acids which include alpha (a) carboxylic acid groups, and a preferred embodiment utilizing glycine. Similar to the fact that a claimed species is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness (*In re Baird*, 16 F.3d 380 (Fed. Cir. 1994)), so to should the lack of specificity within a list of suitable compounds be unable to support a *prima facie* case of obviousness. When looking at Chowhan et al. as a whole, the only preferred compound listed in the examples and the specification is glycine. Other than the

preference for glycine, a person of ordinary skill in the art has no guidance in selecting suitable compounds.

Finally, the instant claims provide surprising results. The specific combination of L-histidine with a very low level of hydrogen peroxide in the presence of preservative improves the antifungal properties of ophthalmic solutions. As shown in example 3 of the specification as originally filed, the samples containing both L-histidine and hydrogen peroxide provide superior antifungal properties when compared to the solutions without hydrogen peroxide.

For these reasons, it is believed that the instant claims are non-obvious over Mowrey-McKee et al. and Chowhan et al., and that this rejection should be reversed.

Rejection under 35 U.S.C. § 103(a) over Mowrey-McKee, Chowhan and Han:

In section 3 of the Office Action dated December 3, 2009, the Examiner has rejected claims 1-20 under 35 § U.S.C. 103(a) as being unpatentable over Mowrey-McKee et al. as modified by Chowhan et al. as applied to claims 1-3 and 5-20 above, and further in view of Han et al. (U.S. Patent No. 5,620,970). This rejection is respectfully urged as in error.

As discussed above, one skilled in the art would not combine the solution of Mowrey-McKee et al. as modified by the solution of Chowhan et al. Additionally, claims 3-20 benefit from dependency of claims 1 and 2, which as discussed above, are patentable. Therefore, it is respectfully requested that this rejection be reversed.

Double Patenting:

In sections 2-6 of the Office Action dated December 3, 2009, the Examiner has raised several provisional rejections on the ground of nonstatutory obviousness-type double patenting.

The Examiner has provisionally rejected claims 1-14, 16 and 18-20 as being unpatentable over claims 2, 4, 7, 8 and 10-19 of copending Application No. 11/613,061.

The Examiner has further provisionally rejected claims 1-20 as being unpatentable over claims 1-5 and 7-13 of copending Application No. 10/544,149 in view of Chowhan et al.

Finally, the Examiner has provisionally rejected claims 1 and 3-12 as being unpatentable over claims 1-5 and 8 of copending Application No. 11/613,050 in view of Chowhan et al.

As these are provisional rejections, Applicant will consider the filing of a terminal disclaimer once there has been an indication of allowable claims in either this or the copending applications.

Conclusion:

For the above reasons, Appellant respectfully requests reversal of the rejection and an indication of allowance for claims 1-20.

In the event that Applicant has overlooked the need for an extension of time, additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefore and authorizes that any changes be made to Deposit Account No.: 50-3010.

Respectfully submitted,
HISCOCK & BARCLAY, LLP

By: 
Jason R. Womer
Reg. No. 60,149
2000 HSBC Plaza
100 Chestnut Street
Rochester, NY 14604
Tel: (585) 295-4400 x 4306
Fax: (585) 295-8431